

### **Remarks**

The above Amendments and these Remarks are in reply to the Office Action mailed May 30, 2006.

Claims 1-10 were pending in the Application prior to the outstanding Office Action. Claims 1-5 are cancelled. In the Office Action, the Examiner rejected claims 6-10. Reconsideration of the rejections is requested.

#### **I. ELECTION/RESTRICTIONS**

In the Office Action, the Examiner writes that "Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, drawn to retrieving the critical data from the FLASH memory, classified in class 711, subclass 103.

II. Claims 6-10, drawn to detecting a low power state then storing the critical data in a FLASH memory, classified in class 711, subclass 105.

...

Applicant's election without traverse of claims 6-10 over the telephone restriction practice is acknowledged. Applicant's election was given in a telephone interview with Paul Durdik (Reg. #: 37,819) on May 12, 2006.

Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim." See OA, page 2-3.

The present Reply A confirms Applicant's election of Examiner's defined invention II, and the withdrawal of claims 1-5. Further, Applicant requests cancellation of claims 1-5. Applicant reserves the right to represent these claims by filing a divisional application directed thereto.

#### **II. OBJECTION TO THE SPECIFICATION**

The Examiner objected to the Specification for the following reason: the cross reference to related application is missing U.S. Patent Application Numbers. This Reply A amends the Specification to cure this defect, and therefore Applicant requests that the objection be removed.

#### **III. DOUBLE PATENTING**

In the Office Action, the Examiner writes that "Claims 6-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-16 of copending Application No. 10/727,678."

The Examiner notes that "A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.” A terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) is submitted herewith.

#### IV. REJECTION UNDER 35 U.S.C. §102(B) OVER *WATTS* (US PAT. 6,336,161 B1)

##### *Claims 6-10*

The Examiner rejected claims 6-10 under 35 U.S.C. §102(b) as being anticipated by *Watts*. Applicant respectfully traverses the rejection.

In the Office Action, the Examiner writes that regarding claim 6 “*Watts* teaches a hard drive device comprising...a DRAM device adapted to store and provide access to critical data (Fig. 5, DRAM 72; column 5, lines 38-44; column 6, lines 6-13); and a FLASH memory, the FLASH memory adapted to store and provide access to data (Fig. 5, Flash 74; column 6 lines 6-13); and a processor, the processor configured to be executed computer code loaded into a cache memory (Fig. 1, CPU 12; column 3, lines 29-31), the computer code including: computer code for detecting a low power state event (Fig. 2a, step 42; column 4, lines 9-13); computer code for retrieving critical data from the DRAM device (Fig. 5; column 5, lines 38-44; column 6, lines 6-13); and computer code for storing the critical data in the FLASH memory (Fig. 2a, step 44; column 2, line 33-36; column 4, lines 13-19).” See OA, page 5, item 1. However, *Watt* fails to disclose a hard drive device comprising “a DRAM device adapted to store and provide access to critical data; and a FLASH memory, the FLASH memory adapted to store and provide access to data” as recited in claim 6. *Watts* describes “once power-down mode begins (block 44), hardware configuration information, which would normally be supplied by the drivers upon start up, is stored in the flash EEPROM.” See col. 4, lines 13-16. Referring to Figure 1 of *Watts*, the flash EEPROM described by *Watt* is **external** to the hard disk drive (“A CPU...is coupled to a semiconductor memory subsystem 13 (including a main memory 14, a Level 2 (L2) cache memory 16, a BIOS (or similar program) memory 18...in many convention computers, the BIOS is stored in a flash EEPROM...” See col. 3, lines 28-31, 52-53).

*Watts* describes multiple embodiments contemplating use of flash memory **external** to the hard disk drive. The claims themselves distinguish between memory of a hard disk drive, and memory external to the hard disk drive, and the specification and claims teach away from the claims of the present invention by making this distinction (e.g., “a hard drive and one or more other devices...said devices having internal memories for storing configuration data...a flash memory...configuration data from said internal memories being stored in said flash memory...” See claim 1, “storing configuration data from internal memories of one or more system devices into a flash memory” See claim 16).

Because *Watts* fails to disclose a hard drive device comprising "a DRAM device adapted to store and provide access to critical data; and a FLASH memory, the FLASH memory adapted to store and provide access to data" as recited in claim 6, *Watts* cannot anticipate claim 6 under 35 U.S.C. §102(b). Dependent claims have at least the features of the claims from which they depend. Claims 7-10 depend from claim 6, therefore *Watts* cannot anticipate claims 7-10 under 35 U.S.C. §102(b).


**V. CONCLUSION**

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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